

REMARKS/ARGUMENTS

Claims 1-18, 20-22 and 25-44 remain in the application for further prosecution. Claims 1, 16, 20, 40 and 43 have been amended.

§102 Rejection

Claims 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2,353,128A (Claypole et al.).

§103 Rejection

Claims 22 is rejected under 35 U.S.C. 103(a) as being anticipated by GB 2,353,128A (Claypole et al.) in view of U.S. Patent No. 6,311,976 B1 (Yosoloff).

Claims 1-17 and 25-41, and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable by GB 2,353,128 A (Claypole et al.) in view of U.S. Patent No. 6,077,163 (Walker et al.).

Claims 18 and 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claypole et al. and Walker et al. in further view of U.S. Patent No. 6,311,976 (Duhamel).

Independent Claims 1 and 25

The Examiner has failed to sale to establish a *prima facie* case of obviousness with respect to independent claims 1 and 25. In rejecting independent claims 1 and 25, the Examiner states the following with respect to Claypole:

Claypole teaches a method of conducting a wagering game on a gaming machine that allows a user to place a wager **(to purchase a series of place of a basic portion of the game where in the single wager is allocated to an entire series of plays (i.e.: a flat rate for a duration or plurality of plays) and not being associated with any one of the series of plays)**. Furthermore, Claypole implements a method of play wherein **in response to a single wager a player is provided a series of randomly generated outcomes of each play ...**

Office action, Page 4. (emphasis added) Without question, the statements are inaccurate and have no support in Claypole. Claypole does not disclose anything whatsoever about a single

wager being allocated to an entire series of plays or resulting in a series of randomly selected outcomes. Nor does the Examiner cite to any specific teachings in Claypole that support the Examiner's positions on page 4 of the Office Action.

In fact, the Examiner seems to admit that Claypole lacks such a teaching by then stating, "Claypole is silent with regard to implementing block wagering, where a single wager is allocated to an entire series of claims and the wager is not being associated with anyone of the series applies." Office Action, pages 4-5. The Applicants respectfully request clarity on the issue of whether the Examiner is relying on Claypole for the teachings of a single wager being allocated to an entire series of plays or resulting in a series of randomly selected outcomes.

Regarding Walker, the Office Action cites to a section of Walker that is suggesting a flat rate based on certain parameters, one of which is the identity of the player. In other words, the player must enter "player identifying information" to determine a flat rate of play. See Walker, Col. 3, lines 17-18. See also Walker, Col. 6, lines 50-55. Later, Walker sets forth an equation for calculating the flat rate, which includes the "Player Status Rating (PSR)" Col. 7, lines 63-64 and Col. 8, lines 30-39. According to the Office Action, the skilled artisan may attempt to combine Walker's player-identity-based flat rate to Claypole's stand-alone game for the purpose of playing a tournament on Claypole's stand-alone game. While it is understood why Walker requires a player identity if a tournament is to take place so that a winner can later be identified, it is unclear why Walker's player-identity-based flat rate would be used in Claypole's game.

First, Claypole's game is a stand-alone game. There is nothing whatsoever in Claypole to suggest that it is linked to a plurality of gaming machines for the purposes of allowing some type of tournament (like Walker teaches). Thus, the Examiner's suggestion of using Claypole's gaming machine in a tournament setting appears misplaced. And second, it is important to consider the specific game that Claypole teaches. In Claypole's game, the goal is not to accumulate any type of items or even achieve a certain position along Claypole's trail (which could be used as a basis for comparing individuals competing in a tournament). While Claypole may allow movement along the trail, it is for the purpose of allowing a player to collect a monetary prize ("jackpot") at the end of the trails 348', 350', 352' or achieve a known, monetary payout along the path as shown in the trail 348 (in units of British pounds). To accomplish this goal of achieving a monetary payout, the player can use the "start/gamble button 130" and the "stop/collect button

126.” See page 11, lines 20-25. As such, while the Examiner suggests a modification to Claypole to place Claypole in a tournament setting, it is absolutely unclear (i) how such a tournament would be conducted on Claypole since Claypole is a stand-alone machine or (ii) how Claypole’s game could be used in any type of tournament format.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682 (see also *In re Fritch*, 972 F.2d at 1260 (Fed. Cir. 1992)). The Examiner must show reasons why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The Applicants do not believe that examiner has discharged his burden of proof in establishing a *prima facie* case of obviousness with regard to independent claims 1 and 25

In addition to the deficiencies in the rejections of independent claims 1 and 25, there are several dependent claims for which a *prima facie* case of obviousness has not been established.

For example, dependent claim 6 requires that the accumulated element is a collected object (as opposed to dependent claim 4, which requires that the accumulated element is a position on a trail, latter, or meter). To reject claim 6, the Office Action states that Claypole discloses that the accumulated element is a collected object. Office Action, page 6. Yet, the Office Action cites to no teaching in Claypole for support for this statement. While the Applicants can understand how the Examiner could state with respect to dependent claim 4 that Claypole discloses a trail, there is no teaching whatsoever regarding the accumulation of any type of object in Claypole. As such, a *prima facie* case of obvious with respect to claim 6 has not been established for this reason as well. Claim 6 is allowable over the cited prior art.

Additionally, claim 7, which is dependent on claim 6, requires the triggering of a bonus in response to a collection of a predetermined number of the objects during the series of plays. Without question, Claypole fails to disclose this limitation as well. As such, dependent claim 7 is also allowable over the prior art.

Dependent claim 11 requires that each play includes at least one random event that is **interdependent** of one or more other plays in the series. Claim 12 is dependent on claim 11 and further modifies claim 11. In the paragraph rejecting claims 9-15 and 34-39, there are **no** statements whatsoever about the “interdependent” limitation of claim 11 or where the Examiner is finding such a teaching in Claypole. Office Action, page 6. Quite to the contrary, the Examiner cites to a portion of Claypole where the Examiner alleges the random event is **independent** on other plays in the series, which is the opposite of the subject matter of claim 11. As such, claims 11-12 are allowable over the prior art.

Dependent claims 30, 31, 35 and 36, which depend from independent claim 25, are similar to dependent claims 6, 7, 11, and 12, which are discussed above. As such, dependent claims 30, 31, 35 and 36 are allowable as well.

Dependent claims 43-44 require redeeming the accumulated element for a **bonus event** before completing the series of plays, **playing the bonus event**, and **continuing the series of plays**. To reject these claims, the Office Action cites to Claypole at p. 11, lines 4-24. While this section of Claypole discusses allowing the player to redeem his or her position for tokens or cash by pressing the “collect button,” there is absolutely no teaching whatsoever of redeeming the accumulated element for a **separate bonus event**, which is played, and then continuing the underlying series of plays after the playing of the bonus event. Nor is there any teaching of the predetermined event corresponding to collection of a predetermined number of the accumulated elements, as set forth in dependent claim 44. As such, the Examiner has also failed to establish a *prima facie* case of obviousness with respect to dependent claims 43 and 44.

Amended dependent claims 16 and 40 are also believed to be allowable over the prior art.

Independent Claim 20

Claim 20 has been amended to require that the winning outcomes are winning symbol combinations including a plurality of symbols. As such, claim 20 now requires a wagering game including a pay table in which “the number of movements varying **with different ones of the winning symbol combinations.**” The present application illustrates such a pay table with winning symbol combinations and associated movements in FIG. 12:

HAND	AWARD
Jacks or Better	1 Move
Two Pair	1 Move
Three of a Kind	2 Moves
Straight	2 Moves
Flush	3 Moves
Full House	4 Moves
Four of a Kind	5 Moves + 25 Credits
Straight Flush	10 Moves + 50 Credits
Royal Flush	20 Moves + 1000 Credits

Claypole may include trails, but the movement along those trails is not dictated by any winning symbol combination. Quite differently, some of the symbols in Claypole have associated points 360 in a corner of the symbol location and movement along those trails is dictated by the points 360 in the corners of the symbols. In other words, movement along Claypole's trail is independent of any winning symbol combination resulting in a prize on the win line 342. See Claypole, page 7-line 26 to page 8, line 14. As such, Claypole cannot anticipate claim 20. Furthermore, Claypole could never be used to render obvious amended claim 20 because to do so would change the principal of operation of Claypole. MPEP § 2143.

Reconsideration of the rejection of amended claim 20 and dependent claim 21 is respectfully requested.

Independent Claim 22

A *prima facie* case of obviousness has also not been established for claim 22. Claim 22 requires a wagering game including a pay table in which winning outcomes are directly associated with respective non-credit-based awards including awards in the form of **"a number of free plays of the game, the number of free plays varying with different ones of the winning outcomes."** The Office Action primarily relies upon Claypole for rejecting claim 22, but specifically relies upon Yoseloff, col. 10, lines 20-24, as disclosing this highlighted claim feature listed above.

But, Yoseloff's statement at col. 10, lines 20-24 is nothing more than a comment on a **prior art** wagering game in which a **certain number** of free plays may be provided to a player when a symbol transforms or morphs. However, this is not what claim 22 is claiming. Claim 22 requires that different ones of the winning outcomes have different numbers of free plays as

dictated by the novel pay table. Neither Claypole nor Yoseloff teach or suggest a wagering game with different winning outcomes directly associated with respective non-credit-based awards in which the non-credit-based awards include a number of free plays that vary with different ones of the winning outcomes.

As the Examiner is aware, to establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art". *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *see also In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (*stating* "[w]hen evaluating the scope of a claim, every limitation in the claim must be considered"). Without question, the Office Action fails to evaluate every limitation in claim 22.

Additionally, the mere fact that references **can** be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682 (see also *In re Fritch*, 972 F.2d at 1260 (Fed. Cir. 1992)). The Examiner must show reasons **why** a skilled artisan, confronted with the same problems as the inventor and with **no** knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Moreover, the showing **must** be clear and particular. See, e.g., *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In this situation, the Examiner states:

Yoseloff offers these types of prizes as an added incentive for players to continue playing while enhancing the experience for the user. One would be motivated to incorporate the free plays into Claypole in order to enhance the experience for the user.

Office Action, p. 4. This statement is improper for several reasons. First, the Examiner cites to no specific section of Yoseloff for support of the statement. Second, as discussed above, Yoseloff's teaching about a free play is in conjunction with a prior art wagering game. As such, Yoseloff could never be offering these "types of prizes as an added incentive for players." And last, but surely not least, the alleged motivation that the Examiner sets forth is directly out of the

Applicant's own specification, which, of course, is improper for establishing a *prima facie* case of obviousness. See Present Specification, Paragraphs 72-75.

Accordingly, the Applicants respectfully submit that the rejection of claim 22 should be withdrawn as a *prima facie* case of obviousness has not been established.

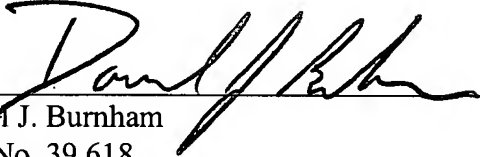
Conclusion

It is the Applicants' belief that all of the pending claims are in condition for allowance and action towards that end is respectfully requested.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number shown.

Respectfully submitted,

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